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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,265	09/29/1999	ETSUKO KIMURA	Q55939	3838

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SUGHRUE MION ZINN MACPEAK & SEAS
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EXAMINER

SING, SIMON P

ART UNIT PAPER NUMBER

2645

DATE MAILED: 10/02/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,265

Applicant(s)

KIMURA, ETSUKO

Examiner

Simon Sing

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claim 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Palatsi US Patent No. 5,892,475.

1.1 Regarding claim 1, Palatsi discloses a portable electronic device in figures 1-4, comprising:

a plurality of soft keys 11 and 12 associated one-to-one with a plurality of guide areas 13 and 14, included in a display area 8 (column 2, lines 25-27, 34-39); and

Control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 2, lines 52-59), wherein operation items selected by a user are displayed hierarchically and at the same time (Figure 4, step 29).

1.2 Regarding claim 2, the portable electronic device of Palatsi is a handy phone (column 2, lines 18-30).

1.3 Regarding claim 3, Palaski discloses a portable electronic device in figures 1-4, comprising:

storing means [memory 6] for storing a plurality of functions which can be selected by a user (column 2, lines 21-24, 57-59);

a display 8 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 2, lines 25-27, 57-59);

a key input section a plurality of soft keys 11 and 12 associated one-to-one with a plurality of guide areas 13 and 14, included in a display area 8 (column 2, lines 25-27, 34-39); and

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 2, lines 52-59), wherein operation items are displayed hierarchically and at the same time (Figure 4, step 29).

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1.4 regarding claim 4, Palatsi discloses that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display, said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figures 2-4; column 2, lines 25-27, 34-39).

1.5 Regarding claim 5, Palatsi discloses that the guide areas comprise character sequence representative of the operation items which can be selected by the user (column 2, lines 52-59).

1.6 Regarding claim 6, the portable electronic device of Palatsi is a handy phone (column 2, lines 18-30).

1.7 Regarding claim 7, Palatsi discloses that the guidance information comprises marks appearing on another display line of said display areas for designating values of set statuses in a form of the operation items which can be selected by the user (column 2, lines 60-67; column 3, lines 1-15).

1.8 Regarding claims 8-10, Palatsi's device is a portable telephone (column 2, lines 18-30).

2. Claims 3-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. US Patent No. 5,737,394.

2.1 Regarding claim 3, Anderson discloses a portable electronic device in figures 2-10, comprising:

storing means [memory 52, figure 3] for storing a plurality of functions which can be selected by a user (column 7, lines 17-35);

a display 18 including a plurality of guide areas each for display respective guidance information representative of an operation item which can be selected by the user (column 5, lines 18-21, 50-64);

a key input section a plurality of soft keys 20 associated one-to-one with a plurality of guide areas 64 included in a display area 18 (column 4, lines 3-8; column 5, lines 18-21);

control means for processing related operation in the guide area when one of said plurality of soft keys is pressed (column 5, lines 39-64; column 11, lines 32-39; column 12, lines 8-19); and wherein

operation items are displayed hierarchically and at the same time, such as in figure 9A, Stem 510, items "VM MSG", "NEW" and "OLD MSG" are displayed in S510.

2.2 regarding claim 4, Anderson discloses that the guide areas comprise a plurality of areas formed by dividing one of a plurality of display lines included in said display,

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said soft keys are being positioned in the vicinity of said display in a same arrangement as said guide areas (figure 2B; figure 4; column 4, lines 3-8).

2.3 Regarding claim 5, Anderson discloses that the guide areas comprise character sequence representative of the operation items which can be selected by the user (column 5, lines 18-21; column 7, lines 32-39; column 12, lines 8-19).

2.4 Regarding claim 7, Anderson discloses that the guidance information comprises marks appearing on another display line of said display areas for designating values of set statuses in a form of the operation items which can be selected by the user (column 12, lines 8-19).

2.5 Regarding claims 6 and 8-10, Anderson's device is a portable telephone (figure 2; column 3, lines 52-58).

Response to Arguments

3.1 Applicant's arguments with respect to claims 1 and 3 [rejected by SUZUKI and Schroeder] and claims 1 and 2 [rejected by Anderson] have been considered but are moot in view of the new ground(s) of rejection.

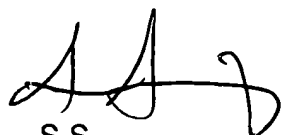
3.2 Applicant's arguments filed on 07/11/2003 regarding claims 3-10 [rejected by Anderson] have been fully considered but they are not persuasive.

Claim 3 merely states: "operation items are displayed hierarchically and at the same time", which does not have the limitation such as: "items selected by the user" (see claim 1).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Sing whose telephone number is (703) 305-3221. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



S.S.
09/17/2003